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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/925,703	09/09/1997	DUANE LE ALLEN	MICL:024(97-	5929

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EXAMINER

OPIE, GEORGE L

ART UNIT

PAPER NUMBER

2126

DATE MAILED: 05/16/2003

27

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	08/925,703	Duane Le Allen	
	Examiner	Art Unit	
	George L. Opie	2126	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-51 is/are pending in the application.
- 4a) Of the above claim(s) ☐ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ☐ is/are allowed.
- 6) ☒ Claim(s) 34-51 is/are rejected.
- 7) ☐ Claim(s) ☐ is/are objected to.
- 8) ☐ Claim(s) ☐ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ☐ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ☐ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119


- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ☐.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ☐
- 17) ☐ Interview Summary (PTO-413) Paper No(s) ☐
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: ☐


ST. JOHN COURTENAY III
PRIMARY EXAMINER

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DETAILED ACTION

This Office Action is responsive to Applicant's request for reconsideration, filed 24 January 2002.

1. Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 34-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of "Microsoft releases Windows 95 service-pack" M2 Communications Presswire, 14 February 1996.

As to claim 34, the APA p4 l8-17) teaches a method comprising: providing an operating system package (OS) that includes a first configuration file (includes a configuration file) the first configuration file including information used by the operating system package to install first drivers (drivers) for a first set of devices (devices ... associated with the computer) on a computer. The APA does not explicitly disclose the additional limitations detailed below. Microsoft Win95 ServicePack Release teaches providing a second configuration file external to the operating system package (ServicePack) the second configuration file including information to direct the installation of a second driver for a second device (new components, tools, and third-party device drivers) installing the second driver on the computer based on the information in the second configuration file (install the latest drivers easily for hardware devices) and installing the operating system package on the computer based on the information in the second configuration file (fixes ... install easily on an existing Win95 based system). It would have been obvious to combine Microsoft Win95 ServicePack teachings with the APA because the ServicePack automates upgrading, OS fixes, and installation of additional drivers for new hardware.

As to claim 35, the APA (background p3 l14 – p4 l2) teaches executing a setup program (software) of the operating system package (OS) to install the second driver (installs whatever drivers the device needs). It would have been obvious

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to combine the installation execution teachings with the APA as modified because the setup program that executes the appropriate OS configuration functions assist the user to complete the installation by simply running the setup program so that the device is fully operational.

As to claim 36, "Official Notice" is taken that the addition of a second device that is not included in the first set of devices for driver installation is well known in the art (MPEP2144.03). It would have been obvious to combine new device installation with the system of the APA as modified because a user may need to add a component on to the machine but the drivers for that new component are not present on the machine, so the second file provides a mechanism for adding new drivers to the system.

As to claim 37, "Official Notice" is taken that installing applications after the second driver and the operating system are installed is well known in the art. It would have been obvious to have the application loading follow the installation of the OS and drivers integrate with the APA as modified because the installation of application programs are dependent on the configuration of the system, and customary setup routines enable efficient installation of a user's software package, including all of the programs that constitute the system applications.

As to claim 38, "Official Notice" is taken that determining one procedure from a plurality of options is well known in the art. (MPEP 2144.03). In the interest of flexibility and efficiency, it would be important to incorporate a mechanism for choosing an installation procedure from a variety of possibilities, and it would have been obvious to combine this option determination principle with the APA as modified, thereby furnishing the installation facility with a feature for determining one procedure for installation from a number of alternatives in order that the setup procedure suits the user's needs.

As to claims 39-40, "Official Notice" is taken that the dynamic identification of devices is automated or user-driven is well known in the art (MPEP2144.03). It would have been obvious to combine the automated/user-driven system of dynamic identification of devices with the APA as modified because the dynamic identification would help set-up the peripheral component configuration for the user with the automated/direct-driven teaching that provides enhanced installation capabilities, i.e. a user-friendly utility that powerfully manages the low-level details requisite in installation of new hardware and system upgrades.

As to claim 41, "Official Notice" is taken that an ISA, PCI, SCSI, and an IDE device are component standards which are well known in the art. (MPEP 2144.03). It would have been obvious to combine components from the

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recited respective device standards with the APA/ServicePack system because the adaptations for the variety of protocols enable automated management, maintenance, and installation for machines equipped with any of the recited device standard components.

As to claim 42, "Official Notice" is taken that a display device, a sound device, a modem, and a controller are components that need respective drivers for the system to function properly is well known in the art (MPEP 2144.03). It would have been obvious to combine the peripheral devices with the APA/ServicePack system because the utilization of these common computing interfaces facilitates a user's ability to enjoy the maximum extent of the machines communication services.

As to claim 43, "Official Notice" is taken that the patching of errors in a first configuration file with information in a second configuration file is well known in the art (MPEP 2144.03). It would have been obvious to employ the file patching concept in the APA as modified because the correcting of errors via patches from one file to a second file facilitates solution implementation/installation, thereby enabling a user to easily maintain the OS package, devices and machine in a properly performing status.

As to claims 44-50, note the rejections of claims 34, 37-39, and 41-43 respectively. Claims 44-50 are the same as claims 34, 37-39, and 41-43, except claims 44-50 are computer program product claims and claims 34, 37-39, and 41-43 are method claims.

As to claim 51, the APA teaches that the device drivers are typically installed during the OS installation, background p4 ln 15-17. Accordingly, the typical scenario would have setup the second device's driver contemporaneously with the OS installation. It would have been obvious to combine this packaging setup with the APA/ServicePack system because the installation of the driver for the second (or any other) device during the OS setup would save time and eliminate the need for the user to perform the software configuration for the device.

3. The prior art of record and not relied upon is considered pertinent to the applicant's disclosure. Each reference disclosed below is relevant to one or more of the Applicant's claimed invention.

U.S. Patent No. 5,713,009 to Derosa et al. which teaches a configuration file for setting-up the system devices and OS;

U.S. Patent No. 5,640,562 to Wold et al. which teaches a facility for installing device drivers and an OS kernel;

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U.S. Patent No. 5,613,125 to Nguyen et al. which teaches a system for controlling devices in conjunction with the OS by means of a special configuration file.

4. Response to Applicant's Arguments:

Applicant argues (claims 34 and 44) that the Microsoft Win95 ServicePack combined with the APA does not meet the "second configuration file" as claimed. Contrary to Applicant's contention, the Microsoft ServicePack does meet the recited second configuration file and its associated limitations. Microsoft's ServicePack is clearly a "second" module or "file" that contains OS and driver configuration information. "The Service Pack includes any fixes that were made to Windows". In other words, the ServicePack installs/configures the OS, and it allows "users to install the latest drivers" for new hardware devices. Hence, the ServicePack does read-on the "second configuration file" and its recited functionality as broadly claimed.

The scope of the claimed "second configuration file" clearly transcends the more narrow scope that Applicant attempts to impute through argument. Claimed subject matter, not the specification is the measure of the invention. Limitations in the specification cannot be read into the claims for the purpose of avoiding the prior art, *In re Self*, 213 USPQ 1,5 (CCPA 1982); *In re Priest*, 199 USPQ 11, 15 (CCPA 1978). The second configuration file and its functions are clearly subject to a broad interpretation, as detailed in the rejections maintained above. The Examiner has a *duty* and *responsibility* to the public and to Applicant to interpret the claims *as broadly as reasonably possible* during prosecution (see *In re Prater*, 56 CCPA 1381, 415F.2d 1393, 162 USPQ 541 (1969)).

Applicant also argues that there is no motivation for combining the references. In response, Examiner notes that the test for the relevance of a cited combination of references is: "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention," *In re Gorman*, 933 F.2d at 986, 18 USPQ2d at 1888. Subject matter is unpatentable under section 103 if it 'would have been obvious ... to a person having ordinary skill in the art.' While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior art specifically suggest making the combination: *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)." Such suggestion or motivation to combine prior art teachings can derive solely from the existence of a teaching, which one of ordinary skill in the art would be presumed to know, and the use of that teaching to solve the same [or] similar problem which it addresses. *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171,

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174 (CCPA 1979). "In sum, it is off the mark for litigants to argue, as many do, that an invention cannot be held to have been obvious unless a suggestion to combine prior art teachings is found in a specific reference." *In re Oetiker*, 24 USPQ2d 1443 (CAFC 1992). Accordingly, the combination of Microsoft Win95 ServicePack teachings would have naturally dovetailed with the APA to facilitate upgrading, OS fixes, and installation of additional drivers for new hardware.

In considering the OS package with a second configuration file and its recited limitations, it is noted that Applicant uses terminology that has broad meaning in the art, and thus requires a broad interpretation of the claims in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant should set forth claims in language that clearly, distinctly, unambiguously and uniquely define the invention. The fact that Applicant has not narrowed the definition/scope of the current claims implies that Applicant intends an extensive coverage breadth of the claims, which is met by the cited prior art. Consequently, the OS package with a second configuration file to update drivers and configure an OS, in the manner recited in the pending claims does not constitute a non obvious improvement over the prior art.

Pursuant to Applicant's seasonable challenge under MPEP §2144.03 in connection with the "Official Notice" of the below listed claims, references are provided as follows:

regarding claim 36, Lipe et al. (U.S. Patent 5,748,980) teaches the concept of installing a second device that is not included in the first set of devices;

regarding claims 37 and 45, Harding (U.S. Patent 5,794,052) teaches the installing applications after the second driver and the OS are installed;

regarding claims 38 and 46, Harding (U.S. Patent 5,794,052) teaches the determining one installation procedure from a plurality of options;

regarding claims 39-40 and 47, Lipe et al. (U.S. Patent 5,748,980) teaches the dynamic identification of devices using automated or user-driven operations;

regarding claims 41 and 48, Lipe et al. (U.S. Patent 5,748,980) teaches the ISA, PCI, SCSI, and IDE device architectures;

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regarding claims 42 and 49, the Admitted Prior Art (Applicant's background) teaches the recited display device, a sound device and a modem; and,

regarding claims 43 and 50, Harding (U.S. Patent 5,794,052) teaches OS installation including, patching of errors in a first configuration file with information in a second configuration file.

Applicant's arguments have been fully considered but they are not deemed to be persuasive. For the reasons detailed above, the rejections set forth in the previous Office Action under **35 U.S.C. § 103** are maintained.

5. THIS ACTION IS MADE FINAL.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Request for copy of Applicant's response on floppy disk:

Please help expedite the prosecution of this application by including, along with your amendment response in paper form, an electronic file copy in WordPerfect, Microsoft Word, or in ASCII text format on a 3½ inch IBM format floppy disk.

Please include all pending claims along with your responsive remarks. Only the paper copy will be entered -- your floppy disk file will be considered a duplicate copy. Signatures are not required on the disk copy. The floppy disk copy is not mandatory; however, it will help expedite the processing of your application. Your cooperation is appreciated.

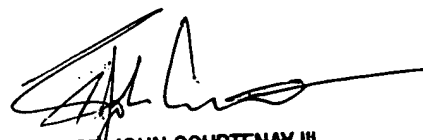
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7. Contact Information:**PTO Policy for Facsimile Submissions:**

- ☐ AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
- ☐ OFFICIAL faxes must be signed and sent to (703) 746-7239.
- ☐ NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date of entry will correspond to the actual FAX reception date unless that date is a Saturday, Sunday, or a Federal Holiday within the District of Columbia, in which case the official date of receipt will be the next business day. The application file will be promptly forwarded to the Examiner unless the application file must be sent to another area of the Office, e.g., Finance Division for fee charging, etc.

- ☐ All responses sent by U.S. Mail should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231
- ☐ Hand-delivered responses should be brought to Crystal Park Two, 2021 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled and entered by the docketing personnel. Please do not hand deliver responses directly to the Examiner.
- ☐ Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at **(703) 305-9600**.
- ☐ Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Opie at (703) 308-9120 or via e-mail at *George.Opie@uspto.gov*. Internet e-mail should not be used where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the Applicant. Sensitive data includes confidential information related to patent applications.



ST. JOHN COURTENAY III
PRIMARY EXAMINER